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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,071	08/25/2000	David Yinkai Chao		6895

25546 7590 01/30/2003

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EXAMINER

DANG, HUNG XUAN

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/648,071	Applicant(s) Chao
	Examiner Hung X. Dang	Art Unit 2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Nov 18, 2002

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-4, 6, and 8-30 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4, 6, and 8-30 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

4) Interview Summary (PTO-413) Paper No(s). _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

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1. The response filed on 11/18/02 has been entered.

Claims Rejection Under 35 USC - 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6 and 8-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,737,054) in view of **Chao** (5,568,207).

Chao '054 disclose that a primary frame (10) including a first bridge (13), the first bridge (13) including a first magnetic (14), an auxiliary lens frame (20) having a second bridge (21) having an arm (22) extended rearward toward the primary frame (10) and extend over the first bridge (13), the arm including a rear end having a flange (24) extended downward for engaging with the first bridge and for securing the auxiliary frame to the primary frame, the flange (24) including a second magnet for engaging with the first magnet (14) and for securing the auxiliary frame to the primary frame. (See figures 1, 2 and 4

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and the related disclosure) Chao '054 does not disclose that two side of the auxiliary frame each having an extension extended rearward toward the primary frame and extended over one of the studs, the extensions each including a rear end having a first flange extended downward.

Chao '207, however, discloses that two side of the auxiliary frame (20) each having an extension (21) extended rearward toward the primary frame (10) and extended over one of the studs (11), the extensions (21) each including a rear end having a first flange (22) extended downward (please see figure 15).

Because Chao '054 and Chao '207 are both from the same field of endeavor, the purpose of preventing the auxiliary spectacle frame from moving downward relative to the primary frame as disclosed by Chao '207 would have been recognized as an art pertinent art of Chao '054.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the auxiliary lenses for eyeglasses, such as the one disclosed by Chao '054, with two side of the auxiliary frame each having an extension extended rearward toward the primary frame and extended over one of the studs, the extensions each including a rear end having a first flange extended downward,

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such as disclosed by Chao '207 for the purpose of preventing the auxiliary spectacle frame from moving downward relative to the primary frame.

Claims Rejection Under 35 USC - 103

3. Claims 1-4, 6 and 8-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,568,207) in view of **Chao** (5,737,054).

Chao '207 discloses auxiliary lenses for eyeglasses which comprising a primary lens frame (10), an auxiliary lens frame (20). The auxiliary lens frame (20) having two magnetic members (22) secure to the arms (21) thereof for engaging with the magnetic members (14) of the primary lens frame (10) for securing the auxiliary lens frame (20) to the primary lens frame (10). Chao '207 does not disclose that the bridge of the auxiliary lens frame having an arm extended over the bridge of the primary lens frame for securing the auxiliary lens frame to the primary lens frame.

Chao '054 disclose that the auxiliary lens frame having a middle bridge portion having a projection for engaging over the middle bridge portion of the primary lens frame and having a

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magnetic connector member for engaging with the connector member of the primary lens frame.

Because Chao '207 and Chao '054 are both from the same field of endeavor, the purpose of providing auxiliary lens frame which may be easily engaged on the primary lens frame as disclosed by Chao '054 would have been recognized as an art pertinent art of Chao '207.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the auxiliary lenses for eyeglasses, such as the one disclosed by Chao '207, with auxiliary lens frame having a middle bridge portion having a projection for engaging over the middle bridge portion of the primary lens frame and having a magnetic connector member for engaging with the connector member of the primary lens frame, such as disclosed by Chao '054 for the purpose of providing auxiliary lens frame which may be easily engaged on the primary lens frame.

Claims Rejection, Obviousness Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by

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a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-4, 6 and 8-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,109,747. Although the conflicting claims are not identical, they are not patentably distinct from each other because claimed invention in claims 1-4, 6 and 8-30 of this application is substantially the same as that in claims of the U.S. Patent No. 6,109,747. All the limitations in claims 1-4, 6 and 8-30 of this application is included in the U.S. Patent No. 6,109,747 and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention

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in claims 1-4, 6 and 8-30 of this application is substantially identical to that of claims in the U.S. Patent No. 6,109,747. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response To argument

6. Applicant's arguments filed 11/18/02 have been fully considered but they are not persuasive.

Applicant argued that: "the present application is a continuation of the application no. 08/847,711, on which Chao'747 issued. Since the interests furthered by the judicially created obviousness type double patenting rejection are not implicated where the subject application was filed after June 8, 1995, and the subject application is related (under 35 U.S.C. @ 120) to the patent/application supplying the basis for the rejection, as is the case here."

It is not understand what's applicant argument.

In order to avoid the nonstatutory double patenting rejection, Applicant must file a terminal disclaimer in

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compliance with 37 CFR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Or to amend the claimed invention to overcome the cited art.

Applicant again argued that: "Neither of Chao'207 nor Chao'054 references teach or suggest the combination, and it is respectfully submitted that action does not provide sufficient explanation of how the skilled artisan would be motivated to combine the modified the teaching of Chao'207 with Chao'504 or vice versa. The mere face that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art."

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

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1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the purpose of providing auxiliary lens frame which may be easily engaged on the primary lens frame and preventing the auxiliary spectacle frame from moving downward relative to the primary frame.

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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9. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (703) 308-0550.

1/03



HUNG DANG

PRIMARY EXAMINER

TECHNICAL CENTER 2800